

## **REMARKS/ARGUMENTS**

### **1.) Examiner Objections – Specification**

The Examiner objected to the specification because of certain informalities. The Applicants have amended the noted portions of the specification in accordance with the Examiner's observations.

### **2.) Claim Rejections – 35 U.S.C. §103(a)**

The Examiner rejected claims 11, 12, 15 and 16 as being unpatentable over Lindquist, *et al.* (U.S. Patent No. 6,983,149) in view of Amerga, *et al.* (U.S. Patent No. 7,369,534) and Stern-Berkowitz, *et al.* (U.S. Patent No. 7,308,264); claims 13 and 17 as being unpatentable over Lindquist, Amerga, Stern-Berkowitz and Schwarz, *et al.* (U.S. Patent No. 7,248,889); claims 14 and 18 as being unpatentable over Lindquist, Amerga, Stern-Berkowitz, Schwarz and Choi, *et al.* (U.S. Patent No. 7,031,277). The Applicants traverse the rejections.

Claims 11 recites:

11. A method in a Radio Network Controlling unit in a mobile telecommunication network for including a detected set cell in an active set, wherein said detected set cell is a cell not identified by the network and said active set is the set comprising the base stations simultaneously connected to the same mobile terminal in soft handover, said method comprising the steps of:

receiving a measurement report comprising a detected set cell from a mobile terminal located in a first cell;

providing a list for the first cell in the network with cells not defined as neighboring cells to the first cell, wherein the cells in the list are grouped based on their scrambling codes;

identifying the scrambling code of the detected set cell;

creating a temporary relation between one of the cells in the list having an identical scrambling code as the detected set cell and one cell in the AS; and,

adding the one of the cells in the list having an identical scrambling code as the detected set cell to the active set.

(emphasis added)

In rejecting claim 11, the Examiner relies on the combined teachings of three references: Lindquist, Amerga and Stern-Berkowitz. With respect to the teachings of

Lindquist, the Examiner asserts that it teaches ""including a detected set cell . . . in an active set," referring to column 4, lines 15-18, as teaching the "detected set cell" and column 1, lines 48-56, as teaching an "active set." The Examiner, however, does not point to any teaching in Lindquist of "including a detected cell set in an active set." At column 4, line 15, *et seq.*, Lindquist defines a "Detected Set" as "[c]ells detected by the UE [user equipment; e.g., a mobile terminal] which are neither in the Active Set nor in the Monitored Set," which is in accordance with the Applicants use of the term in the present application. Lindquist states in that same paragraph, however, that "[the Detected Set] is not further treated in connection with the present invention." (emphasis added) The invention disclosed by Lindquist does not utilize, much less discuss, the inclusion of a detected set cell in an active set. Thus, the Examiner has not identified the teaching of that claim element.

The Examiner has recognized certain deficiencies in the teachings of Lindquist, acknowledging that Lindquist fails to teach "that the cells in the list are grouped based on their scrambling codes; identifying the scrambling code of the detected set cell." To overcome that deficiency, the Examiner looks to the teachings of Amerga, asserting that that claim limitation is taught at column 2, lines 28-31 and column 5, lines 27-29. The Examiner reads too much into the teachings of Amergas. First, Amergas states that "[t]he scrambling code may be associated with one of the cells in a neighbor list." In contrast, however, the Applicants' invention is characterized by "providing a list for the first cell in the network with cells not defined as neighboring cells to the first cell, wherein the cells in the list are grouped based on their scrambling codes." (emphasis added) Furthermore, the Examiner incorrectly states that "[i]t was well know [sic] and common knowledge to a person with ordinary skill in the art at the time the invention was made that scrambling codes uniquely identify each Node B or (base station)." (emphasis added) As the Applicants have noted in the Background portion of the application, "there can be several cells with the same scrambling code." (Page 3, lines 13-14) If multiple cells can have the same scrambling code, then such scrambling codes cannot "uniquely" identify each Noce B. In fact, the limitations of claim 11 presuppose that situation, since a latter claim limitation relates to the step of "creating a temporary

relation between one of the cells in the list having an **identical** scrambling code as the detected set cell and one cell in the AS." Thus, not only does Amerga not teach what the Examiner asserts, the Examiner's technical reading of the claim limitation is incorrect.

Finally, the Examiner also acknowledges the deficiencies in the teachings of Amergas, acknowledging that Lindquist and Amergas fail to teach the steps of "creating a temporary relation between one of the cells in the list having an identical scrambling code as the detected set cell and one cell in the AS," and, "adding the one of the cells in the list having an identical scrambling code as the detected set cell to the active set." To overcome that failure in the teachings of those references, the Examiner then looks to the teachings of Stern-Berkowitz, referring to column 9, lines 9-20. Stern-Berkowitz, however, teaches that "when the signal strength of a candidate cell . . . is greater than the signal strength of any one or more cells in the active set of cells . . . , a measurement report is sent to the network," and "[t]he network typically directs the WTRU to move this candidate cell to the active set of cells." (Column 9, lines 9-16) Stern-Berkowitz does not, as the Examiner suggests, provide any teaching to modify an active set as a function of scrambling codes, much less in the particular manner recited in claim 11.

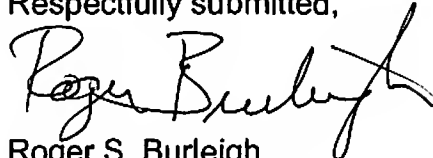
Thus, whereas the cited references fail to teach the individual claim limitations as asserted by the Examiner, much less the combination of those limitations as recited in claim 11, the Examiner has not established a *prima facie* case of obviousness. Whereas independent claim 15 recites analogous limitations, it is also not obvious over Lindquist, Amerga and Stern-Berkowitz. Furthermore, whereas claims 12-14 and 16-18 are dependent from claims 11 and 15, respectively, and include the limitations thereof, they are also not obvious in view of Lindquist, Amerga and Stern-Berkowitz, or further in view of Schwarz and Choi.

### **CONCLUSION**

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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